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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,209	09/29/2003	Shoji Iwasa	O11.2B-11333-US01	2521

490 7590 09/19/2006

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/674,209

Applicant(s)

IWASA, SHOJI

Examiner

Michael A. Marcheschi

Art Unit

1755

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Michael A. Marcheschi
Primary Examiner
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ATTACHMENT TO ADVISORY

Prior to addressing the declaration, the examiner would like to point out that in the tables of this declaration, the print quality is poor, thus making it hard to decipher some of the values in the tables (some of the data appears to be grayed out in the offices copy of the declaration).

Although the print quality is poor, the examiner can ascertain from the description of the declaration what the declaration defines, however, it is requested that a clear copy of the declaration be submitted.

Applicants arguments are based on the supplemental declaration filed 8/28/06. The examiner has reviewed this declaration and this declaration does not realistically show unexpected results for all of the possible combinations of HEC and PEO defined in the claims in comparison to a composition outside the claimed limitations (composition that contains the same components (references) but the amounts and MW are outside the claimed values). The claims define a composition comprising a combination of PEO and HEC, wherein the PEO is present in a defined range (more than 0.005-less than 0.5% PEO) and has a defined molecular weight (30,000-50,000,000) and the HEC is present in a defined range (0.01-3% HEC) and has a defined molecular weight (300,000-3,000,000). The claims also do not define the type of alkaline component and amount thereof. Although, from the tables in the declaration, one can envision ranges of amounts and molecular weight for both the PEO and HEC, the ranges defined in the tables for these components are much more narrow than those claimed and said tables also include other specifics (one specific alkaline component in a specific amount), thus the results are not commensurate in scope with the claims. In other words, applicant only shows data for HEC with a maximum MW of 1,800,000 at a concentration of between 0.05% and 2% and the

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examiner is unclear as to how this would establish criticality for HEC with a MW of more than 1,800,000 to 3,000,000 at a concentration of between 0.01 and 3%, as claimed. Applicant also only shows data for PEO with a MW of between 800,000 and 8,000,000 at a limited concentration defined in the tables and the examiner is unclear as to how this would establish criticality for PEO with a MW of 30,000-less than 80,000 and more than 8,000,000 to 50,000,000 (i.e. highest MW defined in the tables is much lower than the claimed maximum MW). Applicant also never compares the claimed composition with compositions outside the claimed limitations (composition consistent with the references). Applicant does not show criticality for the combination, as claimed (criticality for HEC, PEO, and any alkaline material in the broad amounts and the broad molecular weight ranges). Any evidence provided does not establish criticality for all possible combinations of HEC and PEO with all MW values. Finally, the declaration makes a statement that "the same unexpected results that occur with ammonium at 1% will occur with all alkaline compounds". Applicant fails to support this statement with evidence. Assuming arguendo, the amount of alkaline component would only be limited to 1% and the claims do not define this. The declaration makes a statement that "the same unexpected results will occur with all weight percentages of the alkaline compound". Applicant fails to support this statement with evidence.

In summary, the scope of the data defined in the tables is still not commensurate in scope with the claims and although the examiner can extrapolate the data to determine a trend, no such trend is established in the instant case because the data defined in much narrower than the claimed values (see, for example, the lowest and highest MW of PEO and the highest MW of HEC, as well as when these MW materials are used in various amounts and combination). In

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addition, criticality for any and all amounts of alkaline compound and any and all types of alkaline compounds has not been clearly established since no evidence is provided.

In view of the above, claims 1-5 are rejected for the same reasons set forth in the previous office action.